

51306/502:1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

VALIDATION)
For: SCANNER WITH COUPON))
Filed: December 20, 2000)
Serial No.: 09/745,302)
Joseph F. Rando et al.) Examiner: Karl D. Frech
In re the Application of:) Group Art Unit: 2876

ENT

Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450

Sir:

Pursuant to the duty of disclosure, documents listed on the accompanying Form PTO-1449 (or equivalent) are presented for the Examiner's consideration.

The items identified in this IDS may or may not be "material" pursuant to 37 CFR § 1.56. The submission thereof by Applicant is not to be construed as an admission that any such patent, publication or other information referred to therein is material or considered to be material (37 CFR § 1.97(h)), or even qualifies as "prior art" under 35 USC § 102 with respect to this invention unless specifically designated by Applicant as such.

CERTIFICATE OF MAILING (37 C.F.R. §1.10)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit

Portlnd2-4483391.1 0051306-00502

Sandi Lekar

Name of Person Mailing Paper

Notice of Concurrent Litigation

Pursuant to MPEP § 2001.06(c), the existence of litigation in a parent of the above-identified application is hereby being brought to the attention of the Patent & Trademark Office. Documents related to the litigation are enclosed herewith and listed on the accompanying form.

A. Items CA and CB

On April 30, 2004, a complaint for declaratory judgment of noninfringement and invalidity of Rando et al.U.S. Pat. No. RE37,166 (the 'RE'166 patent), the parent to the present application, was filed in United States District Court for the Southern District of Ohio at Dayton. The suit is identified as NCR Corporation v. PSC, Inc. and PSC Scanning, Inc., Case No. 3:04cv0142. The plaintiff, NCR Corporation, alleges at paragraph 33 that:

"On information and belief, claims of the Asserted Patents are invalid, inter alia, for at least one of the following reasons: they are anticipated under 35 U.S.C. § 102; they are obvious under 35 U.S.C. § 103; the specification does not comply with 35 U.S.C. § 112, first paragraph; and the claims do not comply with 35 U.S.C. § 112, second paragraph."

Defendants, PSC Inc. and PSC Scanning, Inc., have filed a motion to dismiss pursuant to FRCP 12(B)(1) or alternatively to sever and transfer the noninfringement and invalidity counts to the United States District Court for the District of Oregon, Eugene division, where a complaint for infringement of the same patent has been filed. The Ohio court has granted a request by plaintiff, NCR Corporation, to extend the time for filing a response to PSC's motion to dismiss until August 29, 2004.

B. Items CC and CD

On May 5, 2004, PSC Scanning, Inc. filed a complaint for patent infringement against NCR Corporation in the United States District Court for the District of Oregon, Eugene division. The suit is identified as PSC Scanning, Inc. v. NCR Corporation, Civil Action No. 04-06137-AA. The complaint alleges that NCR has infringed the Rando U.S. Pat. No. RE37,166 (the 'RE'166 patent), the parent to the present application. As of the filing of this supplemental information disclosure statement, it is understood that the complaint has not yet been served on the defendant and no answer

has been filed. The court has granted the parties' joint motion to set aside the court's Discovery and Pretrial Scheduling Order.

Information Disclosure Statement Filing Provision:

applicatin 37 (hin threation fil CFR § 1	OS is believed to be timely in that it is being submitted under 37 CFR § 1.97(b), that is see months of the filing date of the application, which is not a continued prosecution ed under § 1.53(d); or (2) within three months of entry of the national stage as set forth .491; or (3) before the mailing of a first Office action on the merits; or (4) before the rst Office action after filing a request for continued examination under § 1.114. Thus, red.				
		However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and charge the fee due under 37 CFR §1.17(p) to the deposit account referenced below.				
		However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and a statement under 37 CFR § 1.97(e) is included below, thus no fee is required.				
	on the r	This IDS is being submitted under 37 CFR § 1.97(c), that is after mailing of a first Office on the merits, but before a Final Action under 37 CFR § 1.113 or a Notice of Allowance 7 CFR § 1.311.				
		The fee due under 37 CFR § 1.17(p) is submitted herewith.				
	\boxtimes	A statement under 37 CFR § 1.97(e) is included below, thus no fee is required. In the event that this IDS is not received before a Final Action or a Notice of Allowance, then Applicant respectfully requests that the Office consider the filing of these papers to be submitted under 37 CFR § 1.97(d) and charge the fee due under 37 CFR § 1.17(p) to the deposit account below.				
A state	1.113 c	OS is being submitted under 37 CFR § 1.97(d), that is after a Final Action under 37 or a Notice of Allowance under 37 CFR § 1.311, but before payment of the issue fee. Inder 37 CFR § 1.97(e) is included below. The fee due under 37 CFR § 1.17(p) is ewith.				
		STATEMENT UNDER 37 CFR § 1.97(e):				
		tem contained in this IDS was first cited in any communication from a foreign patent				
office	in a cou	interpart foreign application not more than three months prior to the filing of this IDS.				

\boxtimes	No item contained in this IDS was cited in a comm	nunication from a foreign patent office in a	
counte	erpart foreign application, and because these compla	aints were filed less than three months ago,	
the atto	orney or agent signing below hereby states that no i	tem of information contained in the	
inform	nation disclosure statement was known to any indivi	idual designated in 37 CFR 1.56(c) more	
than th	nree months prior to the filing of this information di	sclosure statement.	
	Applicant sets forth below concise explanation of	the relevance of each document not in the	
English	h language and/or selected documents(s) in the Eng	glish language.	
	D	Con a con Final	
	PAYMENT AND/OR AUTHORIZATION TO CHARGE FEES: A check in the amount of is enclosed for the above fee(s). Please charge PSC's Deposit Account No. 13-4953 for the above fee(s). The Commissioner is authorized to charge PSC's Deposit Account No. 13-4953 for any fees		
	Please charge PSC's Deposit Account No. 13-495	3 for the above fee(s).	
\boxtimes	The Commissioner is authorized to charge PSC's	Deposit Account No. 13-4953 for any fees	
which	may be required by the filing of this paper by the fi	iling of this paper. 1	
		Respectfully submitted,	
Dated:	: July 26 , 2004 By:	John A. Rafter, Jr.	
		Reg. No. 31,653	
33451 STOE	L RIVES LLP		
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STOEL RIVES LLP 900 SW Fifth Ave., Suite 2600 Portland, OR 97204-1268 (503) 224-3380

The Commissioner is authorized to charge Stoel Rives LLP's Deposit Account No. 19-4455 if the above-referenced Account No. 13-4953 has insufficient funds.

OIST OF LATENTS AND OTHER ITEMS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT JUL 2 9 2004 (Use several sheets if necessary)				CANT'S	258/060 APPLICANT:	SERIAL NO. 09/745,302				
					Rando et al.					
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		OTHER DOCUMEN								
	CA	Complaint for Patent Infringement and Declaratory Judgment, NCR Corporation v. PSC, Inc. and PSC Scanning., Case No. 3:04cv0142 (S.D. Ohio, Dayton), filed April 30, 2004.								
	Civil Docket, NCR Corporation v. PSC, Inc. and PSC Scanning, Inc., Case No. 3:04cv0142 (S.D. Ohio CB printed July 8, 2004.									
	СС	Complaint for Patent Infringement, <u>PSC Scanning</u> , <u>Inc. v. NCR Corporation</u> , Civil Action No. 04-6137-AA (D. Oregon, Eugene), filed May 5, 2004.								

Civil Docket, PSC Scanning, Inc. v. NCR Corporation, Civil Action No. 04-6137-AA (D. Oregon (Eugene)),

DATE CONSIDERED:

Page 1 of 1Portlnd2-4439998.1 0051306-00502

EXAMINER: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include a copy of this form with next communication

CD

EXAMINER:

to applicant

printed July 8, 2004.

Information Disclosure Statement – Section 9 PTO-1449